

### **Remarks**

Applicants respectfully request entry of the present amendment under 37 C.F.R. § 1.116(b) as complying with a requirement of form for claims 10, 15-16, 18, 21, and 48 set forth in a previous office action and as presenting claim 33 in better form for consideration on appeal, which has been provisionally filed concurrently with this response.

Applicants respectfully request reconsideration of the above-identified application. Claims 1-8, 10-33, and 35-48 remain in this application. Claims 10, 15-16, 18, 21, 33, and 48 are amended. Claim 9 has been canceled. Applicants respectfully traverse the rejections as conceivably applied to the pending and amended claims.

#### **I. Allowable Subject Matter**

Applicants note with appreciation the allowance of claims 1-8, 12-14, 27-29, and 35-37.

Applicants also note with appreciation that claim 21 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. To that end, claim 21 has been amended to independent form.

Dependent claims 10, 15-16, 18, and 48 have been amended to depend from allowable claim 21 and accordingly, should also be allowable. Further, un-amended dependent claims 11, 17, and 19-20, which now also ultimately depend from allowable claim 21, should also be allowable.

#### **II. Rejections Based on Hamm and Kochmer.**

As previously presented, claims 22-26, 30-32, and 42-47 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 3,982,991 to Hamm combined with U.S. Patent 3,253,122 to Kochmer.

Independent claim 22 and independent claim 42 both recite that the heating element cross-sectional portion that is unembedded in the front jaw is no less than about 0.55 times the cross-sectional thickness of the resilient portion of the rear jaw. The previous Office

Action recognizes that Hamm fails to disclose this recitation. (Office Action mailed May 21, 2003 at page 6, lines 10-12 and page 10, lines 15-17.)

The previous Office Action states that the Hamm device “could function effectively with a thinner resilient pad such as that disclosed by Kochmer.” (*Id.* at page 6, lines 16-18 and page 11, lines 1-2.) However, the mere fact that Kochmer *could* be combined with Hamm does not render the resultant combination *prima facie* obvious – rather, the prior art must provide the teaching or suggestion supporting the combination. MPEP 2143.01. The Office Action fails to point out *in the prior art* a teaching supporting a motivation for substituting the thin resilient pad of Kochmer for the thick resilient pad of Hamm.

In fact, the thin pad 30 of Kochmer is used in conjunction with a heating element 16 that is *embedded* in the front jaw 10. (Kochmer, Fig. 3.) The thicker pad 10 of Hamm is used in conjunction with a heating element 4 that is *unembedded* in the front jaw 1. (Hamm, Fig. 1.) No reasoning has been set forth on why one would be motivated to use the Kochmer thin pad -- designed for use with an *embedded* heating element -- with the Hamm *unembedded* heating element.

Further, a *prima facie* case of obviousness also requires that the prior art provide a reasonable expectation that the proposed modification will succeed. MPEP §2142. The reasonable expectation of success must *not* be based on Applicant’s disclosure. (*Id.*) In the present case, the Office Action fails to point out any rationale supporting that the proposed modification would reasonably be expected to succeed in providing an increased “life of the welding and parting tool” and easier “production of fault-free and neat seams” as recited in Hamm at column 1, lines 38-41. The Office Action fails to provide any basis (other than the Applicants’ disclosure) for a reasonable expectation that the Hamm device “could function effectively” with Kochmer’s thin resilient pad.

Because there is no cited authority supporting the proposed reason for modifying Hamm or showing a reasonable expectation of success, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. “The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of

record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. The need for specificity pervades this authority.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (cites omitted). The factual question of motivation to combine cannot be resolved on “subjective belief and unknown authority.” *Id.* at 1434. The best defense against improper hindsight-based obviousness is the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Dependent claims 23-26 and 30-32 include additional recitations to those of independent claim 22 and are therefore further patentable over the combination of Hamm and Kochmer. Dependent claims 43-47 include additional recitations to those of independent claim 42 and are therefore further patentable over the combination of Hamm and Kochmer.

Dependent claims 26 and 32 were also rejected as obvious over Hamm and Kochmer further combined with Wiley; however, Wiley fails to supplement the above-noted shortcomings of the combination of Hamm and Kochmer.

### III. Rejections Based on Bergevin or Kochmer Combined with Wiley.

As previously presented, claims 33 and 38-40 were rejected under 35 U.S.C. § 103(a) as obvious in view of U.S. Patent 4,981,546 to Bergevin combined with The Wiley Encyclopedia of Packaging Technology, “Sealing, Heat,” John Wiley & Sons, 1986, Pages 574-578 (“Wiley”). Claims 33 and 41 were rejected under 35 U.S.C. § 103(a) as obvious in view of Kochmer combined with Wiley.

Bergevin is directed to a device for sealing and severing thermoplastic films. (Column 2, lines 30-32.) Kochmer teaches a heat sealer with a heat-sealing wire 16 that is disposed in a longitudinally extending groove 15 in the bar. (Column 2, lines 6-16; Fig. 3.) Bergevin and Kochmer both fail to teach or suggest an unreinforced release sheet. (Office Action mailed May 21, 2003 at page 8, lines 12-13 and page 9, lines 10-11.)

Wiley teaches “Teflon-coated Kapton” (i.e., Teflon-coated polyimide) as an electrically insulating layer to cover the nichrome ribbon of an impulse sealer. (Page 575, column 2.)

Applicants appreciate the Examiner emphasizing the distinction between “release *sheet*” and “release *material*.” (Office Action mailed May 21, 2003 at page 17, lines 16-22.) In view of this distinction, Applicants have amended independent claim 33 to recite that the front jaw release sheet comprises an “unreinforced release *sheet* consisting essentially of fluoroplastic release material” (emphasis added).

The previous Office Action points out that “Wiley discloses an unreinforced release sheet,” namely “Teflon-coated polyimide film.” (Previous Office Action at page 17, lines 17-18.) However, Wiley fails to disclose or suggest an unreinforced release sheet *consisting essentially of*<sup>1</sup> fluoroplastic release material. This is because although the polyimide of Wiley’s Teflon/polyimide film is a release material (Application, page 6, line 21), the polyimide is not a *fluoroplastic* release material.

Thus, the combination of Bergevin or Kochmer with Wiley does not render the invention of claim 33 obvious because the combination fails to teach or suggest all of the claim recitations – namely, an unreinforced release sheet that consists essentially of fluoroplastic release material. *See* MPEP §2143.03.

Dependent claims 38-41 include additional recitations to that of independent claim 33 and are therefore further patentable over the combination of Bergevin and Wiley or Kochmer and Wiley.

#### IV. Conclusion

In view of the above amendments and these remarks, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

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<sup>1</sup> The claim recitation “consisting essentially of” has a special meaning in patent law. When the phrase is used with a clause in the body of a claim, it limits the clause to only the specified materials that follow and those additional materials “that do not materially affect the basic and novel characteristics” of the recited elements of the clause. MPEP §2111.03.

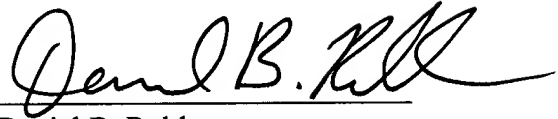
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel B. Ruble", written over a horizontal line.

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